

U.S. Application No. 10/027,215 Examiner Issing, Art Unit 3662
Response to Final Office Action

REMARKS

The United States Patent and Trademark Office (the "Office") rejected claims 36, 37, 39, and 40 under 35 U.S.C. § 112 for insufficient disclosure. Claims 16, 33, 35, and 38 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tennison and as being unpatentable over Elliot. The Assignee presents this § 1.116 amendment after final, and request for reconsideration, in an effort to put the pending claims in a condition for allowance.

Discussions with Examiner Issing

Examiner Issing previously discussed an allowance of claims 16 and 33. On April 30th the attorney faxed a proposed amendment to the Examiner. This proposed amendment was in response to the first Office Action. On Monday, May 5th at 9 AM the attorney and Examiner Issing discussed this proposed amendment. The attorney pointed out that none of the cited references disclose communicating position information "when the battery power of the wireless device reaches a predetermined level." While the reference to Brown (U.S. 6,392,565) mentions power requirements, *Brown* only discusses the low power requirements of the device (see column 4, line 67; column 5, lines 21-23; and column 5, lines 54-56). Examiner Issing agreed, and a formal amendment was presented May 9th.

The attorney was then surprised to receive a final Office Action. A rejection of claims 16 and 33 was maintained, despite the May 5th agreement. The attorney then again spoke with Examiner Issing, but Examiner Issing could not recall the previous agreement. Examiner Issing also did not recall ever receiving the proposed amendment. The Appendix to this response includes a photocopy of the proposed amendment. The Appendix also includes a photocopy of the auto-reply return receipt confirmation, showing the proposed amendment was transmitted April 30th.

This Final Office Action is Procedurally Improper

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The Examiner erroneously imposed a final Office Action. The Examiner did not make a *prima facie* case of obvious in the first Office Action, so the Assignee was under no obligation to present evidence of non-obviousness. The Assignee pointed this out in the response to the first Office Action and in discussions with the Examiner. Because the Examiner did not satisfy his *prima facie* burden, the Examiner cannot now impose a final office action. The Assignee, then, asks the Examiner to reconsider and to reopen prosecution.

The Manual of Patent Examining Procedure makes this very clear. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify "some suggestion or motivation...to modify the reference"; 2) the Examiner must identify "a reasonable expectation of success"; and 3) "the prior art reference must teach or suggest all the claim limitations." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). **The Examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. See *id.* at § 2142. "If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." *Id.* (emphasis added). Only when the Examiner makes a *prima facie* case does the burden shift to the applicant to present evidence of nonobviousness. See *id.* (emphasis added).**

This final Office Action, then, is procedurally improper. The Examiner did not make a *prima facie* case of obviousness in the first Office Action. The Examiner had the initial burden of supporting a *prima facie* case. The Examiner, however, failed to satisfy the three *prima facie* criteria in the first Office Action. **When the Assignee pointed out the deficiencies in the Examiner's *prima facie* case, the Examiner bolstered his argument and issued this final office action. This is impermissible. The Examiner cannot reinforce his *prima facie* case and, in the same office action, close prosecution. This is procedurally improper and a violation of due process.**

The first Office Action failed to satisfy the three *prima facie* criteria. When the first Office Action rejected claims 16 and 33 as being obvious, the Examiner's argument failed to

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satisfy the three *prima facie* criteria. The Examiner's entire line of reasoning in the first office is reproduced below:

Each of *Tennison et al*, *Brown* or *Elliot* teach the subject matter substantially as claimed including a wireless device to be monitored, which device is operable using a battery source. It is well-known that battery sources' power supply drain upon use. In view of the desired uses of the three prior art patents for providing tracking in the event of theft or abduction, it would have been obvious to the skilled artisan to modify the wireless devices such that a location message would be transmitted upon detection of a battery level reaching a threshold beyond which the device would be inoperative so as to provide an updated track of the stolen or abducted device.

See Examiner Gregory C. Issing, first Office Action, page 4.

No where did the examiner show that the all the claim limitations were taught. As the Assignee pointed out in the response to the first Office Action, neither *Tennison*, *Brown*, nor *Elliot* discloses communicating position information "when the battery power of the wireless device reaches a predetermined level." *Brown* is the only reference that mentions power requirements, and this patent only discusses the low power requirements of the device (see U.S. 6,392,565 at column 4, line 67; at column 5, lines 21-23; and at column 5, lines 54-56). Because the Examiner failed to show that all the claim limitations were taught, the Examiner's *prima facie* case failed, and the Assignee had no obligation to present evidence of non-obviousness. **The Examiner cannot reinforce his *prima facie* case and, in the same office action, close prosecution. This final Office Action is, therefore, procedurally improper and a violation of due process.**

No where did the examiner identify "a reasonable expectation of success." The Examiner, in fact, wholly failed to even mention this criterion in the first Office Action. When the Assignee responded and pointed out that the *prima facie* case must fail, the Examiner bolstered his argument in the second office action and closed prosecution. **The Examiner cannot reinforce his *prima facie* case and, in the same office action, close prosecution. This final Office Action is, therefore, procedurally improper and a violation of due process.**

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This final Office Action, then, is procedurally improper. The Examiner bore the initial burden of factually supporting a *prima facie* case of obviousness. When the Examiner failed to consider the three *prima facie* criteria in the first Office Action, the Assignee had no obligation to rebut with evidence of nonobviousness. The Assignee need only point out the deficiencies. The Examiner is certainly permitted to bolster his *prima facie* case in a second Office Action, however, the Examiner cannot make that same second Office Action final. This is impermissible. The Examiner cannot reinforce his *prima facie* case and, in the same office action, close prosecution. This is procedurally improper and a violation of due process. The Assignee, then, asks the Examiner to reconsider and to reopen prosecution.

Rejection of Claims Under 35 U.S.C. § 112

The Office rejected claims 36, 37, 39, and 40 under 35 U.S.C. § 112 for insufficient disclosure. Claims 36, 37, 39, and 40, however, have been cancelled with this amendment, so the rejection is moot.

Rejection of Claims Under 35 U.S.C. § 103 in view of *Tennison*

Claims 16 and 33 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Tennison*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). *Tennison* does not teach or suggest all the claim limitations, so the Examiner's *prima facie* case must fail.

The Examiner admits that *Tennison* does not teach all the claim limitations. The Examiner admits, at page 3, line 6 of the second and final Office Action, that "Tennison et al do

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not specify a communication of position when the battery reaches a predetermined level.” While *Tennison* does mention sensors that monitor fuel or other fluids, direction, temperature, pressure, and speed (*see* paragraph [0013]), *Tennison* fails to teach or to suggest “causing the position information to be communicated to the database via the wireless network when battery power of the wireless device reaches a predetermined level.” *Tennison*, in fact, makes no mention of communicating sensor information at any predetermined condition, other than timing. Even though the “control processor 24” of *Tennison* gathers sensor information, this information is communicated “much less frequently that the data is collected and stored.” *See* paragraph [0016]. *Tennison* admits that the preferred embodiment collects and stores sensor information “every fifteen minutes,” but this sensor information is only communicated “every four hours.” *See* paragraph [0016]. *Tennison* again repeats that the sensor information is communicated “much less frequently” that the collection and storage. *See* paragraph [0019]. *Tennison* even discusses several timing algorithms for determining when information is communicated. *See, e.g.,* paragraphs [0018], [0019], [0020], [0021], and [0022]. Thus, *Tennison* in no way teaches or suggests “causing the position information to be communicated to the database via the wireless network when battery power of the wireless device reaches a predetermined level.” One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Tennison* to communicate position information when the battery power reaches a predetermined level. **Because *Tennison* does not teach or suggest all the claim limitations, *Tennison* cannot obviate the claims of this application. *Tennison*, then, cannot support the Examiner’s *prima facie* case of obviousness, and the Examiner is required to remove the rejection.**

The Examiner does not understand his burden. As the M.P.E.P. makes very clear, “**If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.**” M.P.E.P., § 2143 (emphasis added). **Only when the Examiner makes a *prima facie* case does the burden shift to the applicant to present evidence of nonobviousness.** *See id.* (emphasis added). As the Assignee has repeatedly explained, the Examiner has the initial burden of showing that all claim limitations are taught. As the Assignee stated in the first response, and as this second Office Action admits, *Tennison*

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does not teach all the claim limitations. The Examiner has failed to satisfy his burden, and the Examiner is required to remove the rejection.

One last error in regards to *Tennison*. At page 4, line 1 of the second office action, the Examiner states "applicant's argument that there is no reason to combine the references is not persuasive." No such argument was made in the response to the first office action. The response to the first office action reiterated the three *prima facie* criteria and the Examiner's failure to carry his burden.

Rejection of Claims Under 35 U.S.C. § 103 in view of *Elliot*

Claims 16 and 33 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Elliot*. Once again, if the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. M.P.E.P., § 2143 (emphasis added). *Elliot* does not teach or suggest all the claim limitations, so the Examiner's *prima facie* case must fail.

The Examiner again admits that *Elliot* does not teach all the claim limitations. The Examiner admits, at page 4, line 12 of the second and final Office Action, that "*Elliot* differs from the claimed subject matter since the user device is not specified as causing the position to be sent upon the detection of the battery level reaching a predetermined level." The Examiner is correct — *Elliot* does mention a "power level indicator light 24" that may flash when the battery needs recharging. The Examiner, however, stretches this feature too far to obviate claims 16, 33, 35, and 38. *Elliot* fails to teach or to suggest "causing the position information to be communicated to the database via the wireless network when battery power of the wireless device reaches a predetermined level." *Elliot*, like *Tennison*, makes no mention of communicating position information at any predetermined condition, other than timing. As

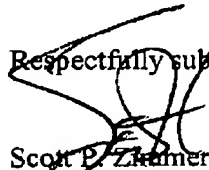
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Elliot explains, the child locator transmits position information "when triggered by an internal timer on a periodic basis." See column 5, lines 13-14. The device may also transmit position information when an emergency button is pushed. See column 5, lines 16-18. "In addition, the device may transmit its data signal after receiving a second signal from a central control system." See column 5, lines 19-20. This central control system may request position information according to a timer or a schedule (column 5, lines 23-24) or a parental request (column 5, lines 24-30). Thus, *Elliot* in no way teaches or suggests "causing the position information to be communicated to the database via the wireless network when battery power of the wireless device reaches a predetermined level." One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Elliot* to communicate position information when the battery power reaches a predetermined level. **Because *Elliot* does not teach or suggest all the claim limitations, *Elliot* cannot obviate the claims of this application. *Elliot*, then, cannot support the Examiner's *prima facie* case of obviousness, and the Examiner is required to remove the rejection.**

The Assignee has made a good-faith effort to put claims 16, 33, 35, and 38 in a condition for allowance. The attorney for the Assignee has also spent considerable time and effort reviewing the *prima facie* requirements and burdens for 35 U.S.C. § 103 rejections. The Assignee respectfully asks Examiner Issing to consider the amendments and remarks and to allow claims 16, 33, 35, and 38.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,


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APPENDIX